

Notice of Allowability

Application No.

09/868,889

Examiner

Janet L. Coppins

Applicant(s)

HANGELAND ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicants' After-Final Amdmt of May 6, 2005.
2. ☒ The allowed claim(s) is/are 1-12,14,17-22,27 and 29.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

PD

DETAILED ACTION

Claims 1-12, 14, 17-22, 27, and 29 pending in the instant application.

Response to Amendment

1. Receipt is acknowledged of Applicants' After-Final Amendment, filed May 6, 2005, which has been reviewed by the Examiner. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Therefore, the amendments to the claims have been entered.

2. Accordingly, claim 13 has been canceled, and claims 1 and 18 have been amended.

Claim Rejections - 35 USC § 102 and Double Patenting

3. Pursuant to the telephone conversation of April 27, 2005, in which the rejections to claims 1, 2, 5-14, 17, 19, 22, 27, and 29 under 35 USC 102(f) and the judicially created doctrine of double patenting were discussed, the Examiner withdraws the rejections to the claims.

Claim Objections

4. The objections to claims 3 and 4 have been obviated and are therefore withdrawn.

Allowable Subject Matter

5. Claims 1-12, 14, 17-22, 27, and 29, newly renumbered as claims 1-21, are allowable.

The following is an examiner's statement of reasons for allowance: This invention relates to novel (4-oxo-substituted-3-alkylphenoxy)-phenyl compounds and compositions that are thyroid receptor ligands, and their methods of use for treating certain skin disorders or diseases. The claimed compounds are found allowable because certain benzamide compounds are known to those skilled in the art as useful thyroid receptor ligands. However the aspect of modifying the known phenoxy-phenyl structures as instantly claimed is novel and unobvious. The closest

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of prior art fails to teach or render obvious the preparation of the aforementioned compounds that contain the same abovementioned phenoxy-phenyl moiety. For example, U.S. 6,395,784 disclose benzamide compounds as thyroid receptor ligands, however the '784 patent does not recited the same compounds as instantly claimed, since it requires an "R₄" substituent on the phenyl ring and an additional carboxylic acid moiety in the "R₆" variable. Therefore, the prior art of record does not teach or fairly suggest the instant claimed compounds or their utility as thyroid receptor ligands for treating skin disorders or diseases.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Telephone Inquiry


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins
May 13, 2005


JOSEPH K. MCKANE
SUPERVISORY PATENT EXAMINER
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